



Paper 4

Intellectual Property Department
BASF Corporation
3000 Continental Drive-North
Mount Olive NJ 07828-1234

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MAR 19 2002

OFFICE OF PETITIONS

In re Application of
Waldemar Pfrengle
Application No. 09/879,258
Filed: June 12, 2001
For: FUNGICIDAL
TRIAZOLOPYRIMID-7-YLIDENEAMINES

Decision Refusing Status
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition filed January 10, 2002 (certificate of mail date)¹, to accord 37 CFR 1.47(b) status to the present application.

The petition under 37 CFR 1.47(b) is dismissed.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Extensions of time under §1.136 are available. **Failure to respond will result in abandonment of the application.**

On August 10, 2001, a Notice to File Missing Parts was mailed requiring the submission of a properly signed oath or declaration in compliance with 37 CFR 1.63. In response to the Notice, on January 10, 2002, a petition under 37 CFR 1.47 (b) was filed.

The petition filed January 10, 2002, states that status under §1.47(b) is proper because a letter dated August 20, 2001 was sent to the inventor, Waldemar Pfrengle at his last known address, that the documents were received by a Mrs. Pfrengle and that since the inventor has received the application documents and hasn't responded that he refuses to sign the declaration. In support thereof, applicants submitted *inter alia* copies of a transmittal letter from a person named Matthias, an August 20, 2001 letter to inventor Pfrengle in German, a postcard receipt in German, a statement jointly signed by Drs. Meyer and Koster of BASF Aktiengesellschaft, and a declaration of facts by patent attorney Charles Costello.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) proof of irreparable damage. Applicant lacks item (1), (2), (5) and (6) set forth above.

As to item (1), Petitioner should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show that the inventor has refused to join in the application. Petitioner has provided a copy of a post card receipt (in German) signed by someone and claims that the signature is that of a Mrs. Pfrengle. The signature is not legible and therein the proof submitted is not conclusive evidence that Waldemar Pfrengle has been presented with the application documents. See Manual of Patent Examining Procedure, Section 409.03(d). The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. If an employee of BASF Aktiengesellschaft prepares and presents the papers to inventor Pfrengle, then their declaration of facts should be submitted on renewed petition.

Additionally, the post card receipt is not dated and thus because it is in a language other than English, it can't be determined that the application documents were a part of a mailing to the inventor at the last known address.

¹The instant petition was made timely by an accompanying petition for a three-month extension of time.

Furthermore, exhibit 2 which purports to be the application papers mailed to the last known address of inventor Waldemar Pfengle is in a language other than English but the Declaration provided is in English. If it is that Mr. Pfengle understands English, the application should be presented to him in English or else the USPTO won't be able to determine if in fact the papers presented are in fact what petitioner alleges them to be.

While Exhibits 3 and 4 appear to be a translation of the words "Patent Application" it still can't be determined what if anything was sent to Mr. Pfengle. As well, petitioner should be reminded of the provisions of 37 CFR 1.69, which provide that:

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

As to item (2), An oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented as an oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of Mr. Pfengle is required. The declaration provided is blank. See MPEP 409.03(b).

As to item (5), Petitioner has failed to show or provide proof that Drs. Meyer and Koster or Matthias for that matter, has sufficient proprietary interest, on behalf of BASF, in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant (company), a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant;

As to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

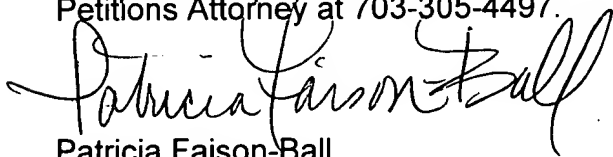
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at 703-305-4497.



Patricia Faison-Ball
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy